

REMARKS

Claims 1-18 and 23-25 are pending in the present application. Claims 19-22 remain cancelled. Claim 1 has been amended.

SPECIFICATION

The specification stands objected to for lacking proper headings. Accordingly, Applicants submit a substitute specification adding headings and reformatted with paragraph numbering. The substitute specification is identical to the originally filed specification and does not introduce new matter. Applicant respectfully requests that the substitute specification be approved.

Additionally, by this amendment, Applicants have added a new Abstract section that was missing from the original specification as filed.

REJECTION UNDER 35 U.S.C. § 112

Claims 1-18 and 23-25 stand rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point and distinctly claim the subject matter which Applicant regards as the invention.

The Examiner contends that the claimed elements of claim 1 are unclear. Accordingly, Applicants have amended claim 1 to positively claim all of the elements contained in claim 1.

By this amendment, Applicants believe that the rejection of claim 1, as well the rejection of all of the claims depending therefrom has been overcome.

The Examiner contends that claims 24 and 25 fail to define any structural limitations of the device and are merely directed to the intended use of the device.

Applicants submit that since both claims 24 and 25 depend from claim 1 and claim 1 provides the necessary device limitations, claims 24 and 25 should be allowable as presented. Reconsideration is respectfully requested.

REJECTION UNDER 35 U.S.C. § 102

Claims 1-4, 8, 15 and 24-25 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Neukermans (WO 97/30565).

The Examiner contends that Neukermans discloses an inner ear stimulation prosthesis having an implantable portion in the form of a rod capable of transmitting vibrations, generated by excitation means to the semicircular canal of the patient's inner ear.

As the Examiner is well aware, a rejection under 35 U.S.C. §102(b) can only be maintained if a single reference teaches each and every element of the claims. If there are any differences whatsoever between the reference and the claim(s), the rejection cannot be based on 35 U.S.C. §102. Titanium Metals Corp. v. Banner, 778 F.2d 775, 227 USPQ 773 (Fed. Cir. 1985).

Upon detailed review of the Neukermans reference, Applicants submit that Neukermans fails to teach the features of an entirely passive implantable portion including a rod portion which extends from an external portion including excitation means for generating vibrations.

Since all of the claim elements are not taught by Neukermans, Applicants respectfully request that the rejection be reconsidered.

REJECTION UNDER 35 U.S.C. § 103

Claims 5-7, 9-14, 16-18 and 23 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Neukermans (WO 97/30565).

Initially, Applicants note that in order to support a rejection under 35 U.S.C. §103, the Examiner must establish that there is some suggestion, either in the reference or in the relevant art, of how to modify what is disclosed to arrive at the claimed invention. In addition, "[s]omething in the prior art as a whole must suggest the desirability, and, thus, the obviousness, of making the modification to the art suggested by the Examiner. *Uniroyal, Inc. v. Rudkin-Wiley Corp.*, 837 F.2d 1044, 1051, 5 U.S.P.Q.2d (BNA) 1434, 1438 (Fed. Cir.), *cert. denied*, 488 U.S. 825 (1988). That is, although the Examiner may suggest that the teachings of a primary reference could be modified to arrive at the claimed subject matter, the modification is not obvious unless the prior art also suggests the *desirability* of such modification. *In re Laskowski*, 871 F.2d 115, 117, 10 U.S.P.Q.2d (BNA) 1397, 1398 (Fed. Cir. 1989).

Applicants suggest that Neukermans fails to provide the requisite motivation for the presently claimed subject matter. As noted above in the §102 rejection, Neukermans does not teach or disclose a device wherein the internal portion is entirely passive. Further, Neukermans fails to teach or disclose an external portion including excitation means which generate vibrations and transmit the vibrations through an

extended rod from the external portion of the patient's inner ear. Applicants suggest that the current rejection has been derived by classic hindsight reconstruction.

CONCLUSION

It is believed that all of the stated grounds of rejection have been properly traversed, accommodated, or rendered moot. Applicant therefore respectfully requests that the Examiner reconsider and withdraw all presently outstanding rejections. It is believed that a full and complete response has been made to the outstanding Office Action and the present application is in condition for allowance. Thus, prompt and favorable consideration of this amendment is respectfully requested. If the Examiner believes that personal communication will expedite prosecution of this application, the Examiner is invited to telephone the undersigned at (248) 641-1600.

Respectfully submitted,

Dated: August 1, 2008

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